

REMARKS

Applicants hereby add new claims 24-29 and cancel claims 2 and 22. Accordingly, claims 1, 3-21 and 23-29 are pending in the present application.

Claims 1-2, 5-10, and 13-16 stand rejected under 35 USC 102(e) for anticipation by U.S. Patent No. 6,681,349 to Sekizawa. Claims 17, 20-21 and 23 stand rejected under 35 USC 103(a) for obviousness over Sekizawa in view of U.S. Patent No. 6,130,757 to Yoshida et al. Claims 3 and 11 stand rejected under 35 USC 103(a) for obviousness over Sekizawa in view of U.S. Patent No. 6,631,967 to Saruta. Claim 18 stands rejected under 35 USC 103(a) for obviousness over Sekizawa and Yoshida in view of Saruta. Claim 22 stands rejected under 35 USC 103(a) for obviousness over Sekizawa and Yoshida in view of U.S. Patent Publication No. 2002/0002492 to Okazawa. Claims 4 and 12 stand rejected under 35 USC 103(a) for obviousness over Sekizawa in view of U.S. Patent No. 5,335,048 to Takano et al. Claim 19 stand rejected under 35 USC 103(a) for obviousness over Sekizawa in view of Takano.

Applicants respectfully traverse the rejections and urge allowance of the present application.

Referring to the anticipation rejections, Applicant notes the requirements of MPEP §2131 (8th ed., rev. 2), which states that TO ANTICIPATE A CLAIM, THE REFERENCE MUST TEACH EVERY ELEMENT OF THE CLAIM. The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

Referring to independent claim 1, the method recites limitations of previously-pending claim 2. The Office on page 6 of the Action states that claim 2 is rejected for the same reasons presented with respect to claim 10. At page 10 of the Action, the Office states that Sekizawa teaches the limitations of claim 10. Applicants respectfully disagree.

Claim 1 now recites forwarding a message to the proper party of the respective consumable responsive to the comparings. In support of the rejection, the Office identifies the status report of Fig. 40A as allegedly teaching the claimed limitations regarding the message. However, the Office has failed to identify any teachings in

Sekizawa of forwarding the status report to a proper party as claimed.

More specifically, Fig. 40A illustrates printer status histories printed on a local printer as disclosed at col. 18, lines 47-48 of Sekizawa. It is stated at col. 40, lines 33+ of Sekizawa that CPU 130 of the console unit 20 prepares print data to print printer status histories of Fig. 40A. It is stated that the CPU 130 instructs the local printer 9 coupled with the console unit 20 to print the status report of Fig. 40A. The Office has failed to identify any teachings that the printing using the local printer 9 discloses or suggests forwarding a message to a proper party of the consumable. The console unit 20 provides monitoring of plural agents 10 and the printing of the status report at a local printer 9 of the console unit 20 may not be fairly interpreted to teach or suggest the forwarding of the message to the proper party as explicitly claimed. Further, Applicants have been unable to identify any teachings in Sekizawa that the mere inclusion of an e-mail address of the corporation in the status report of Fig. 40A discloses the claimed forwarding. Applicants have been unable to locate any teachings in Sekizawa that the status report is communicated to a proper party but is rather printed using the printer 9 of the console unit 20. Positively-recited limitations of claim 1 are not disclosed nor suggested by the prior art and claim 1 is allowable for at least this reason.

The claims which depend from independent claim 1 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

For example, referring to the rejection of claim 3, it is stated that Sekizawa fails to teach the disabling and relies upon the teachings of Saruta. The Office states on pages 9-10 that the motivation for the combination is to prevent the printer from trying to print sheets that it is not capable of printing correctly saving printing resources. Applicants respectfully submit that the alleged motivation is insufficient. In particular, printers P are generally configured to not proceed with printing when a consumable is expended and there is no need or motivation to complicate the systems to communicate a status of exhaustion of the consumable (sensed by the printer) to a remote device and to receive a disablement command therefrom when the printers already have the ability to pause printing when a consumable runs out. As discussed in further detail below, the Office has failed to establish a proper prima facie 103 rejection without proper

motivation and claim 3 is allowable for at least this reason.

Referring to independent claim 9, it is recited that the *processing circuitry is configured to control outputting of a communication responsive to the received party identifier not matching the stored party identifiers*. At page 3 of the Action, it is stated that database management section 24 of Sekizawa compares information in order to update database information. Applicants have failed to uncover any teachings of the claimed communications responsive to no matching of the party identifiers as recited in claim 9. Further, there is no motivation to modify Sekizawa teachings regarding the updating status to arrive at the limitations of claim 9. Applicants respectfully submit that claim 9 recites limitations not disclosed nor suggested by Sekizawa and claim 9 recites allowable subject matter over the prior art for at least this reason.

The claims which depend from independent claim 9 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Referring to independent claim 17, the device recites limitations of previously-pending claim 22. At page 11 of the Action, the Office relies upon the teachings of Okazawa as allegedly disclosing the limitations of previously pending claim 22. Applicants respectfully submit that the reliance is misplaced.

More specifically, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See, e.g., MPEP §2143 (8th ed., rev. 2).

On page 11 of the Action, it is stated that the motivation for the combination of Okazawa with Sekizawa and Yoshida is to let the monitoring apparatus know the status of the printer, including for correcting any consumable empty errors are that now gone and printing can resume. Applicants respectfully submit the motivation is deficient. More specifically, the motivation is redundant to teachings already explicitly disclosed in Sekizawa and accordingly provides no impetus for one of ordinary skill in the art to combine the reference teachings.

In particular, Sekizawa is replete with teachings regarding a polling arrangement of communications intermediate agent units 10 and respective printers P. For example, at col. 26, lines 55+ of Sekizawa, the agent unit 10 may provide a status request command to a printer which then reads status information from the status buffer and returns the status information. Accordingly, Sekizawa explicitly discloses an arrangement wherein agent units 10 poll printers for status information. There is no motivation to alter the arrangement of Sekizawa to operate as defined in claim 17 wherein the printer outputs information responsive to insertion of a consumable.

In addition, referring to col. 29, lines 10+ of Sekizawa, it is disclosed that a time period T1 is monitored and if an elapsed time is longer than the time period T1, the CPU 30 transmits a status request command to the printers to retrieve the status information. At Fig. 15, the time period is adjustable and is explicitly disclosed as having a printer *monitoring interval of 1 minute* in at least one embodiment. Accordingly, Applicants respectfully submit that the explicit disclosure of Sekizawa provides continual, repeated monitoring of printers in an explicitly disclosed polling arrangement. Further, Sekizawa already illustrates that the monitoring interval is adjustable at Fig. 15 if 1 minute is not sufficient. There is no evidence of record that any improvement would be gained or any solution to a problem would be provided by the proposed modifications to Sekizawa over the already disclosed teachings of Sekizawa. Applicants respectfully ask why would one modify a first reference using a second reference when the first reference already provides teachings for which the second reference is presented? Applicants respectfully submit the only reason is motivation improperly based upon Applicants' disclosure of the present application in view of the lack of any evidence of record to support the modification. The motivation for forming the combination must be something other than hindsight reconstruction based on using Applicant's invention as a road map for such a combination. *See, e.g., Interconnect Planning Corp. v. Feil*, 227 USPQ 543, 551 (Fed. Cir. 1985); *In re Mills*, 16 USPQ2d 1430 (Fed. Cir. 1990).

In addition, Applicants respectfully submit that the motivational rationale provided by the Office is insufficient in view of the Federal Circuit authority of *In re Lee*, 61 USPQ 2d 1430 (Fed. Cir. 2002). The motivation identified in the Office Action is akin to the conclusory statements set forth in *In re Lee* which were found to fail to provide the requisite motivation to support an obviousness rejection. The Court in *In re*

Lee stated the factual inquiry whether to combine references must be thorough and searching. It must be based on objective evidence of record. The Court in *In re Fritch*, 23 USPQ 2d 1780, 1783 (Fed. Cir. 1992) stated motivation is provided only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. The *Lee* Court stated that the Examiner's conclusory statements in the *Lee* case do not adequately address the issue of motivation to combine. The Court additionally stated that the factual question of motivation is material to patentability and can not be resolved on subjective belief and unknown authority. The Court also stated that deficiencies of cited references cannot be remedied by general conclusions about what is basic knowledge or common sense. The Court further stated that the determination of patentability must be based on evidence.

In the instant case, the record is entirely devoid of any evidence to support motivation to combine the teachings apart from the bald conclusory statements of the Examiner which are insufficient for proper motivation as set forth by the Federal Circuit. There is no evidence of record that extensively modifying the printers of Sekizawa to initiate communications would offer any benefits over the polling arrangements already disclosed by Sekizawa. The only motivation presented in the Office Action is based upon the Examiner's subjective belief or unknown authority which is insufficient as clearly held by the applicable authority. As set forth by the Federal Circuit, there is no motivation and the Office Action has failed to establish a prima facie case of obviousness and accordingly the 103 rejection of claim 17 is improper.

Applicants respectfully submit that claim 17 is allowable at least for the above-mentioned compelling reasons.

The claims which depend from independent claim 17 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Support for the amendments and new claims may be found at least at Figs. 4-5 and the associated specification teachings of the originally-filed application.

Applicants respectfully request allowance of all pending claims.

The Examiner is requested to phone the undersigned if the Examiner believes such would facilitate prosecution of the present application. The undersigned is

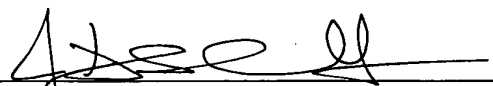
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Amendment A

available for telephone consultation at any time during normal business hours (Pacific Time Zone).

Respectfully submitted,

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